

REMARKS

Claims 1-2 and 4-10 remain in the application, with claim 1 in independent form. Specifically, claim 1 has been amended, claim 3 has currently been cancelled, and claims 2 and 4-10 remain unchanged. Claim 1 has been amended to include the element of original claim 3. No new matter has been added in this Amendment.

Comments

While the Applicants make no concession as to the propriety of the Examiner's rejections within the instant Office Action, Claim 1 has been amended merely to clarify the sealing silicone rubber composition of the present invention in an effort to facilitate prosecution of the pending application. Specifically, the sealing silicone rubber composition employed in the present invention is a hydrosilylation reaction-curable silicone rubber composition, with support found in original claim 3 and paragraph [0066] of the instant specification. As such, no new matter has been added in this Amendment.

Claim Rejections - 35 USC §103

Claims 1-10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the "Background Art" section of the instant application (characterized by the Examiner in the instant Office Action as the "Applicant's Admitted Prior Art", hereinafter "AAPA") in view of U.S. Patent No. 6,888,259 to Ishikawa et al. (hereinafter, "Ishikawa") and/or U.S. Patent No. 6,492,204 to Jacobs (hereinafter, "Jacobs"). The Applicants respectfully traverse these rejections. Specifically, in view of the instant amendment to claim 1, and further in view of the arguments herein, the Applicants respectfully assert that the Examiner has failed to properly establish a *prima facie* case of

obviousness with regard to independent claim 1. In addition, even if a *prima facie* case of obviousness has been properly established, the *prima facie* case of obviousness is rebutted.

Referring to the instant Office Action, the Examiner is combining the teachings of the AAPA and Ishikawa and/or Jacobs in an attempt to arrive at the instant invention, as originally claimed. Further, in the instant Office Action, it is clear that the Examiner has chosen to rely upon MPEP §2144.07 in an attempt to establish the instant rejections.

As correctly noted by the Examiner, the AAPA completely lacks any teaching or suggestion of using a sealing silicone rubber composition (see page 2 of the instant Office Action). However, the Examiner then errs by broadly characterizing the teachings of Ishikawa and Jacobs, and asserting that “a silicone rubber composition is a known in the art encapsulant” and the “use of conventional materials to perform their known functions is obvious” (see page 3 of the instant Office Action). The Applicants must respectfully disagree with the Examiner’s characterization of the prior art and therefore, **the Applicants must respectfully disagree with the Examiner’s assertion of obviousness with regard to the present invention.** In view of the foregoing, it is clear that a *prima facie* case of obviousness has not been properly established by the Examiner. In addition, even if a *prima facie* case of obviousness has been properly established, the *prima facie* case of obviousness is rebutted.

The Examiner is reminded that MPEP §2144.07 can only be used to establish *prima facie* obviousness, not obviousness, and therefore, can be rebutted by the Applicants. Further, existing precedent provides guidance for establishing a motivation to modify a reference or references. In particular, “[t]he motivation to modify the prior

art **must** flow from some teaching in the art that suggests the desirability or incentive to make the modification needed to arrive at the claimed invention.”¹

Importantly, the mere fact that references *can* be combined or modified **does not** render the resultant combination obvious **unless** the prior art also suggests the **desirability** of the combination.² In addition, “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.”³

Further, the current state of the law in terms of the obviousness standards, even post-KSR⁴, **does not** provide the Examiner with *carte blanche* to develop obviousness rejections in any acceptable manner. In other words, the Examiner is not merely enabled to find each element of a claimed combination *somewhere* in the prior art, and then piece each element together **in light of the teachings of the present invention** to then *reach* the present invention. “This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.”⁵

Regarding the prior art, the relevant AAPA relates to paragraph [0005] of the instant application, as noted by the Examiner, which describes general compression molding steps. *However*, the AAPA **completely fails** to teach or even suggest the use of a sealing silicone rubber composition in a mold, as originally claimed for the present invention, i.e., before

¹ Emphasis added; see *Alza Corp. v. Mylan Laboratories Inc.*, 391 F.3d 1365 (Fed. Cir. 2004).

² See *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990).

³ See *In re Wilson*, 424 F.2d 1382, 1385 (C.C.P.A. 1970).

⁴ *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007).

⁵ Emphasis added; see *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004).

the instant Amendment, let alone the hydrosilylation reaction-curable silicone rubber composition as now claimed.

To fill in the deficiencies of the AAPA, the Examiner then relies, in error, on Ishikawa and/or Jacobs because they each generally disclose the use of a silicone rubber composition and/or encapsulation of integrated circuits and/or electrical components. However, both **Ishikawa and Jacobs fail to teach or even suggest the use of a mold**, let alone a step of compression molding, as originally claimed for the present invention. Further, both Ishikawa and Jacobs fail to teach or even suggest the use of the hydrosilylation reaction-curable silicone rubber composition in a mold as now claimed.

With reference to Ishikawa, Ishikawa merely teaches the use of first and second potting materials, specifically, a silicone rubber *and* an epoxy resin (see, e.g., Fig. 8C and column 5, lines 4-20 of Ishikawa). Ishikawa focuses on use of a dispensing machine, such that application of each of the two different potting materials is controlled in a manner as to dictate location of each of the potting materials on specific electronic components. Therefore, from the teachings of Ishikawa with regard to potting materials, one skilled in the art would not choose to employ a silicone rubber composition in a mold, for at least the reason that controlling location of different potting materials within a mold would be extremely difficult relative to merely using a dispensing machine for disposing a potting material on top of a substrate. Further, Ishikawa teaches that each of the potting materials must be hardened at a different temperature and for a different period of time (see, e.g. column 5, lines 4-30 of Ishikawa), such that use of a mold would be extremely difficult and/or highly inefficient. Said another way, Ishikawa does not teach, motivate, or even suggest the use of a silicone rubber composition for use in a

mold, let alone for compression molding as the Examiner is asserting. Instead, Ishikawa expressly directs one skilled in the art to use a dispensing machine for potting materials. As such, the Examiner has not properly established that the prior art “recognized the use of” silicone rubber compositions for molding, and therefore, the *prima face* case of obviousness over the combination of the AAPA and Ishikawa has not been properly established by the Examiner. In addition, while further argument is not necessary in view of the instant rejections, it is also noteworthy that Ishikawa surely does not teach, motivate, or even suggest the use of a *hydrosilylation reaction-curable* silicone rubber composition for use in a mold.

With reference to Jacobs, Jacobs expressly teaches that silicones are **undesirable** for use as encapsulants for electronic devices, because silicones are “sufficiently polar” such that they “absorb water and salts” (see, e.g. column 10, lines 5-12 and especially column 20, lines 38-43 of Jacobs). As such, contrary to the Examiner’s assertions, Jacobs explicitly teaches away from the use of silicones for purposes of encapsulation. Instead, Jacobs focuses on the use of prepolymers formed from isocyanates for encapsulation (see, e.g. column 3, lines 14+ of Jacobs) rather than employing silicone compositions. Said another way, Jacobs does not teach, motivate, or even suggest the use of a silicone rubber composition for use as an encapsulant, let alone for use of a silicone rubber composition in a mold as the Examiner is asserting. As such, the Examiner has not properly established that the prior art “recognized the use of” silicone rubber compositions for molding, and therefore, the *prima face* case of obviousness over the combination of the AAPA and Jacobs has not been properly established by the Examiner. In addition, it is noteworthy that Jacobs surely does not teach, motivate, or

even suggest the use of a hydrosilylation reaction-curable silicone rubber composition for use in a mold.

Conclusions

In view of the clarifying amendment and arguments detailed above, the Applicants respectfully submit that claim 1, as amended, is both novel and non-obvious, in view of the disclosure, teachings, and suggestions of the prior art such that claim 1, as well as the claims that depend therefrom, are in condition for allowance.

If any additional fees are necessary to respond to the outstanding Office Action, you are hereby authorized to charge such fees to Deposit Account No. 08-2789 in the name of Howard & Howard.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS PLLC

Date: July 1, 2009

/David M. LaPrairie/
David M. LaPrairie, Registration No. 46,295
450 West Fourth Street
Royal Oak, MI 48067-2557
(248) 723-0442